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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/319,142 07/29/99 WINTER

E 45/235LI/SC

EXAMINER

IM52/0604

ROBERT W BECKER & ASSOCIATES
11896 N HIGHWAY 14 SUITE B
TIJERAS NM 87059

CHEVALIER, A

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/319,142

Applicant(s)

WINTER ET AL.

Examiner

Alicia Chevalier

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

RESPONSE TO AMENDMENT

Continued Prosecution Application

1. The request filed on April 23, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/319142 is acceptable and a CPA has been established. An action on the CPA follows.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. §112 rejections of record in paper #10, page 2, paragraphs #2-5 have been withdrawn due to Applicant's amendment in paper #11.

REJECTIONS REPEATED

3. The 35 U.S.C. §103 rejection of claims 16-18, 20, 22-27, and 29-31 over Nassau (5,882,786) in view of Gregory (2,521,846) is repeated for reasons previously of record in paper #8, pages 4-7, paragraph #8.

4. The 35 U.S.C. §103 rejection of claims 19, 21, and 28 over Nassau (5,882,786) in view of Gregory (2,521,846) and in further view of Lampert (5,431,028) is repeated for reasons previously of record in paper #8, pages 7-8, paragraph #9.

NEW REJECTIONS

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plate-shaped support must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

7. Claims 16-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is unclear in scope, which renders it vague and infinite. It is unclear from the specification, drawings, and claim language if the plate-shaped support is part of the final gemstone product. Is the plate-shaped support merely used to shape the precious stone layer or is it part of the final product to enhance the decorative qualities of the precious stone layer.

The phrase "plate-shaped support has (100) or (111) orientation" in claim 18 is unclear which renders the claims vague and indefinite. It is unclear what 110 and 111 is suppose to represent in reference to the orientation, i.e. angle, size, etc.

The phrase "a hardness sufficient to coat said plate-shaped support with said precious stone layer" in claim 20 is unclear which renders the claim vague and indefinite. For purposes of examination is phrase is taken to me that the plate-shaped support is of sufficient hardness to be cable of supporting a precious stone layer coated on the plate-shaped support.

The term "grain boundaries" in claim 27 is unclear which renders the claim vague and indefinite. The specification on page 5 discusses "grain boundaries" and "crystal orientation." It

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is unclear how these "grain boundaries" and "crystal orientation" are related or if they are one and the same. If they are one in the same is the precious stone layer a multi-crystalline structure with crystals oriented in the same direction and is achieved by how the layer is formed by the materials used to form the layer?

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 16, 20, 22-24, 27, 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Meyer (229,328).

Meyer discloses an Imitation precious stone comprising an imitation precious stone and a cap that conforms to the shape of the stone made of metal or any other material. See columns 1-2.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT

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discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation that the precious stone layer is produced by vapor phase deposition is a method of production and therefore does not determine the patentability of the product itself. The same is for the limitations that the depression is produced mechanically by cutting or stamping or by etching, the upper surface of the precious stone layer is cut, and the precious stone layer has color produced by doing.

Claim Rejections - 35 USC § 103

10. Claims 17, 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (229,328).

Meyer discloses the claimed invention except for the plate-shaped support made of a silicon wafer, a precious metal, or refractive metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these materials, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. One of ordinary skill would be motivated to use one of these materials as the plate-shaped support depending upon the optical effect desired.

11. Claims 18, 25, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer (229,328).

Meyer discloses the claimed invention except for the claimed orientations, what the pyramid angles are, and that the plate-shaped support surfaces are curved.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the orientations, the pyramid angles, and that the plate-shaped support

surfaces. One skilled in the art would have been motivated to do so in order to fit different shapes of precious stones in the cap.

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments filed in paper #11 regarding the 35 U.S.C. §112 rejections of record have been considered but are moot since the rejections have been withdrawn.

13. Applicant's arguments filed in paper #11 regarding the 35 U.S.C. §103 rejections of record have been considered carefully but have been deemed unpersuasive.


Applicant argues that the cited combination of referenced neither show nor suggest the claimed combination of features of amended claim 16. The Examiner respectfully disagrees for reasons of record in paper #8, pages 4-8, paragraphs #8-9.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 305-5436. The fax number for after final papers is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700